

REMARKS

Summary of the Office Action

In the Office Action, claims 1-13, 17-29, 33-45, 49 and 50 were pending.

In the Office Action, claims 1-13, 17-29, 33-45, 49 and 50 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,163,771 to Walker et al. ("Walker") in view of U.S. Patent No. 6,575,372 to Everett et al. ("Everett"). Claims 20, 21, and 33-45 are rejected under 35 U.S.C. § 112 as allegedly indefinite.

Applicants' reply

Applicants' representative thanks the Examiner for his time during the telephonic interview of March 28, 2008. The Examiner and Applicants' representative discussed the cited references and claim rejections as set forth in the Office Action, and the Examiner requested that Applicants submit this formal Response. Applicants look forward to the Examiner's response to this paper, and respectfully invite the Examiner to contact Applicants' representatives at any time to discuss this application if the Examiner determines that these claims are not in condition for allowance.

In this amendment and response, Applicants address the Examiner's objections and rejections. Claim 33 is amended to correct an informality. Support for this amendment can be found throughout the application. As such, no new matter has been added. This amendment is made solely to expedite prosecution and does not constitute an acquiescence to any of the Examiner's objections or rejections. Applicants reserve the option to further prosecute the same or similar claims in a subsequent application. Upon entry of the Amendment, claims 1-13, 17-29, 33-45, 49 and 50 are pending.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 20, 21, and 33-45 are rejected under 35 U.S.C. § 112 as allegedly indefinite. Specifically, the Examiner alleges that claim 33 is a system claim that also recites method steps, and as such, is allegedly indefinite. Applicants respectfully disagree. The alleged “method steps” are *features* of the claimed *system*. Specifically, the rejected claims all recite systems that *comprise* among other things, the alleged method steps. (See claims 20, 21, and 33-45). As such, it is believed that these claims are in condition for allowance.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-13, 17-29, 33-45, 49 and 50 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Walker in view of Everett.

To reject claims in an application under Section 103, an examiner must establish a *prima facie* case of obviousness. Using the Supreme Court’s guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines “obviousness” as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350 (U.S. April 30, 2007), the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be rigidly applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. Importantly, the Court emphasized

that a patent examiner 's analysis under Section 103 should be made explicit in order to facilitate review.

Thus, to establish a *prima facie* case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. The Examiner must then provide: (1) an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claimed features. See M.P.E.P. §§ 706.02(j) and 2143.

Claim 1 is directed to a method for generating identification data that includes, among other things, "providing an ATM PIN related to a first transaction type that is an ATM transaction" and generating a non-ATM electronic commerce PIN...to be entered by a user...in a non-ATM financial transaction." No such combination is disclosed in or suggested by Walker or Everett, whether considered individually or in combination.

No Motivation to Combine

As an initial matter, Walker is directed to a method and device for generating a single-use financial account number. (*See* Walker, Abstract). In contrast, Everett describes a multi-application IC card system having selective application loading and deleting capability. (*See* Everett, Abstract). The cited references are concerned with solving very different problems, and there would be no reason or likelihood of success for one of ordinary skill to combine the teachings of Walker with the method described in Everett. The Examiner has not established a *prima facie* case of obviousness for at least these reasons.

Independent Claim 1

Assuming, *arguendo*, that there was a reasonable likelihood of success and a motivation to combine Walker and Everett, the combination still would fail to disclose or suggest all elements of claim 1.

With respect to claim 1, the Examiner alleges that Walker discloses a method for generating a second numerical code on a central computer by performing a cryptographic operation on the first numerical code and cryptographically computed data. (*See* Office Action, page 4).

First, the Examiner has not stated that Walker discloses the claim feature of “generating a non-ATM electronic commerce PIN on a central computer by performing a cryptographic operation on said ATM PIN, said non-ATM electronic commerce PIN to be entered by a user in a second transaction type that is a non-ATM financial transaction; and transmitting said non-ATM electronic commerce PIN to said user” as recited in claim 1. “Generating a second numerical code on a central computer by performing a cryptographic operation on the first numerical code and cryptographically computed data” as described by the Examiner does not disclose or suggest this feature of claim 1.

In addition, the two codes generated in Walker are utilized in the same transaction (and therefore inherently the same “transaction type”), whereas claim 1 requires the user to enter the non-ATM electronic commerce PIN in a “second transaction type” and, accordingly, not the same transaction type. Walker is directed to a method and device for generating a single-use financial account number. In Walker, a first and second data element are encrypted and

combined “to generate a *single-use financial account identifier*.” (Walker, Abstract, emphasis added). Regarding one particular embodiment cited by the Examiner, Walker describes, “[t]he steps for generating an encrypted *single-use* credit card number according to this embodiment are shown in FIG. 8.” (Walker, col. 8, lines 9-11). Again, Walker describes a system that involves a single transaction and does not disclose or suggest a second transaction as featured in claim 1.

The Examiner alleges that Everett discloses transmitting codes to a device such as a smart card over a network. (See Office Action, page 5). Assuming, *arguendo*, that this is the case, Everett does not overcome the deficiencies of Walker described above.

For at least these reasons, Applicants respectfully submit that claim 1 is non-obvious and patentable over Walker in view of Everett. Independent claims 17, 33, and 49 contain similar features to those recited in independent claim 1 and should be allowed for at least these same reasons.

Dependent Claims 2-13, 18-29, 34-45, and 50

Since claim independent claims 1, 17, 33, and 49 are allowable, their respective dependent claims, 2-13, 18-29, 34-45, and 50, are also allowable.

Based on the foregoing Amendment and Remarks, Applicants traverse Examiner’s rejection of claims 13-23 under 35 U.S.C. § 103 and 35 U.S.C. § 112.

CONCLUSION

On the basis of the foregoing Amendments and remarks, Applicants respectfully submit that the pending claims of the present application are allowable over the prior art of record. Applicants thus respectfully request the previous rejections be withdrawn, and that the pending claims be allowed by the Examiner. Favorable consideration and timely allowance of this application are respectfully requested. In the event that the application is not deemed in condition for allowance, the Examiner is invited to contact the undersigned at (212) 408-2538 in an effort to advance the prosecution of this application.

Respectfully submitted,



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